

**UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA**

GILBERT P. HYATT,

Plaintiff,

v.

UNITED STATES PATENT AND
TRADEMARK OFFICE, *et al.*,

Defendants.

Case No. 2:14-cv-00311-LDG (GWF)

ORDER

Plaintiff Gilbert Hyatt, has filed this suit under 5 U.S.C. §706(1) of the Administrative Procedure Act (APA) seeking a declaration that Defendants United States Patent and Trademark Office and its Deputy Director Michelle Lee (collectively, USPTO), have unreasonably delayed reaching a final resolution on 80 patent applications that he has filed. He also requests an injunction compelling a final decision on the applications. The USPTO moves to dismiss the entire complaint for lack of subject matter jurisdiction (including an argument that the Federal Circuit or the Eastern District of Virginia share exclusive jurisdiction), and for failure to state a claim. The USPTO alternatively moves to strike Hyatt's request for declaratory relief. Hyatt opposes the motions (#24), but argues that if this Court determines that exclusive jurisdiction lies in the Federal Circuit or the

1 Eastern District of Virginia, that the Court transfer rather than dismiss the matter. Having
2 considered the arguments of the parties, the Court finds that this matter must be
3 transferred, as jurisdiction to hear the suit is exclusive to either the Federal Circuit or the
4 Eastern District of Virginia. Accordingly, the Court will transfer the action to the Eastern
5 District of Virginia.

6 Under *Telecommunications Research and Action Center v. FCC*, 750 F.2d 70 (D.C.
7 Cir. 1984) (“*TRAC*”) and its progeny, “where a statute commits review of final agency action
8 to [a particular] court of appeals, the appellate court has exclusive jurisdiction to hear
9 lawsuits alleging agency inaction where the relief sought might affect the court’s future
10 statutory power of review.” *American Farm Bureau v. EPA*, 121 F. Supp. 2d 84, 91 (D.D.C.
11 2000); see also *Env’tl. Def. Fund v. U.S. Nuclear Regulatory Comm’n*, 902 F.2d 785 (10th
12 Cir. 1990) (showing that *TRAC* confers exclusive jurisdiction over APA section 706(1)
13 claims in the court of appeals); *In re Bluewater Network*, 234 F.3d 1305 (D.C. Cir. 2000)
14 (same); *Sierra Club v. Thomas*, 828 F.2d 783 (D.C. Cir. 1987) (same); *American Bird*
15 *Conservancy v. FCC*, 408 F. Supp. 2d 987, 997-98 (D. Hawaii 2006) (because of exclusive
16 avenue of review in Ninth Circuit, to seek accelerated disposition, “Plaintiffs may seek a
17 writ of mandamus in the [Ninth Circuit] court of appeals”); *City of Yakima v. Surface*
18 *Transp. Bd.*, 46 F. Supp. 2d 1092, 1096 (E.D. Wash. 1999).

19 As alleged by Hyatt, he brought this suit under the APA to compel the USPTO to
20 decide 80 patent applications that, he alleges, have been pending before the USPTO for
21 over 18 years. He alleges that, “[t]o ensure “effective relief,” this Court should place a strict
22 deadline on the [USPTO] for decisions in each of these 80 appealed cases. The Court
23 should require the Appeal Board to decide each of these appeals on a schedule of at least
24 one-per-month beginning within three months from the date of this Court’s judgment.”

25 In opposing the USPTO’s argument that the Federal Circuit and the Eastern District
26 of Virginia share exclusive jurisdiction—and thus that this Court lacks jurisdiction—to hear

1 this lawsuit, Hyatt does not dispute that both the Federal Circuit and the Ninth Circuit have
2 endorsed the *TRAC* doctrine. See, e.g., *In re Paralyzed Veterans of Am.*, 392 F. App'x
3 858, 859-60 (Fed. Cir. 2010); *Public Util. Comm'r of Oregon v. Bonneville Power Admin.*,
4 767 F.2d 622, 626 (9th Cir. 1985). He also does not dispute that he has brought a lawsuit
5 alleging inaction by the USPTO, and that he seeks an accelerated disposition of his patent
6 applications. He also does not dispute that, by statute, the Federal Circuit and the Eastern
7 District of Virginia have exclusive jurisdiction to review the final decisions of the USPTO
8 Appeal Board. 35 U.S.C. §§ 144, 145. Rather, quoting *Moms Against Mercury v. FDA*,
9 483 F.3d 824, 827 (D.C. Cir. 2007), he argues that the *TRAC* doctrine does not apply
10 because the "prospective jurisdiction is a speculative chain of events." The D.C. Circuit
11 determined that the *TRAC* doctrine did not apply when the D.C. Circuit would have
12 exclusive review of one possible final action, but that exclusive review over alternative, final
13 actions was with a district court. Hyatt concedes that, if the USPTO denies him a patent
14 application, he must appeal that decision to either the Federal Circuit or the Eastern District
15 of Virginia. He argues, however, that if the USPTO grants his application, he "would be
16 able to enforce his patent (if necessary) in any appropriate federal district court . . . and the
17 court would have jurisdiction to adjudicate the validity of the issued patent." The argument
18 is without merit as irrelevant. This court's original jurisdiction over civil actions relating to
19 patents does not grant this court jurisdiction to review the decisions of the USPTO. *Pregis*
20 *Corp. v. Kappos*, 700 F.3d 1348, 1357-59 (Fed. Cir. 2012) ("Allowing competitors to
21 collaterally attack issued patents through suits under the APA would destroy the Patent
22 Act's careful framework for judicial review at the behest of particular persons through
23 particular procedures."). Indeed, the Federal Circuit expressly recognized that attacking
24 the validity of issued claims through the litigation defenses enumerated under 35 U.S.C. §
25 282 was not a mechanism "to obtain review of the reasons for allowance of claims." 700
26 F.3d at 1358. While this Court has jurisdiction to determine the validity of a patent, it lacks

1 jurisdiction to review the decision of the USPTO. It may be, as Hyatt implicitly argues, that
2 a final decision of the USPTO will not be directly appealed if the patent is granted.
3 However, if the final decision of the USPTO is appealed, that appeal must be taken to
4 either the Federal Circuit or the Eastern District of Virginia. The prospective jurisdiction of
5 those courts over any appeal of the USPTO's final decision is not speculative. As Hyatt
6 alleges delayed action by the USPTO and seeks an injunction compelling the USPTO to
7 issue a final decision on his patent applications, this Court lacks jurisdiction over this
8 lawsuit.

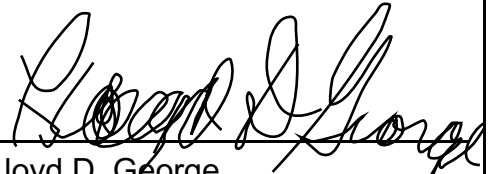
9 Hyatt argues that the appropriate action upon a determination that exclusive
10 jurisdiction lies in either the Federal Circuit or the Eastern District of Virginia is to transfer
11 this action, rather than dismiss the action. He further requests transfer to the Eastern
12 District of Virginia. The USPTO agrees that a transfer would be appropriate, but suggests
13 that the Federal Circuit would be a more appropriate venue. The USPTO notes that, if this
14 matter is transferred to the Eastern District of Virginia, the decision will ultimately be
15 appealed to the Federal Circuit. As Hyatt has brought this suit seeking to hasten the
16 agency action, a transfer directly to the Federal Circuit presents the avenue of least delay.
17 The Court finds the reasoning of the USPTO more persuasive. However, the Court will
18 grant Hyatt's request because, as plaintiff in this litigation, he could elect to file his suit in
19 any appropriate forum, including the Eastern District of Virginia, even if that might result in
20 greater delay in obtaining the relief Hyatt ostensibly seeks.

21 Finally the Court notes that, in deciding to transfer this matter to the Eastern District
22 of Virginia, it has not decided any of the remaining arguments raised by the USPTO. This
23 Court has decided only that this Court lacks jurisdiction over Hyatt's claims.

24 Accordingly, for good cause shown,
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1 THE COURT **ORDERS** that the Clerk of the Court shall promptly transfer this action
2 to the Eastern District of Virginia.

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4 DATED this 30 day of September, 2014.

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7 Lloyd D. George
8 United States District Judge
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